

REMARKS

Claims 1-33 are pending in this application. By this Amendment, claims 1, 7, 8 and 33 are amended. No new matter has been added. Reconsideration based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Kramer in the October 26 and 28, 2004 telephone interviews. Applicants' separate record of the substance of the interviews is incorporated into the following remarks.

As a preliminary matter, Applicants understand that this Action is non-final as is indicated at 2b. of the Office Action Summary despite the statements to the contrary at paragraph 15 of the Office Action. This is the first Office Action after Applicants filed a Request for Continued Examination of this application on June 30, 2004.

The Office Action, in paragraph 1, objects to claims 7-10 and 33 for certain informalities. Claims 7, 8 and 33 are amended to obviate the objection. Withdrawal of the objection to claims 7-10 and 33 is respectfully requested.

The Office Action, on page 5, indicates that claims 4-6, 8, 9 and 12-28 recite allowable subject matter. Applicants appreciate this indication of allowability but respectfully submit that at least claim 1, from which the enumerated claims indirectly depend, is allowable for at least the reasons set forth below.

The Office Action, in paragraph 3, rejects claims 1-3, 7, 10, 11, 30 and 33 under 35 U.S.C. §102(b) as being anticipated by German Patent No. DE 19807328 to Köth et al. (hereinafter "Köth"), noting that U.S. Patent No. 6,349,801 to Köth et al. is used as the English language equivalent. This rejection is respectfully traversed.

Applicants respectfully submit that claims 1 and 33 were previously amended to change the language from "wherein at least a rotatable component of the drive is rotatably supported on the screw" to "wherein at least a rotatable component of the drive is rotatably

supported with respect to the screw." These amendments were made to overcome a previous rejection of the enumerated claims as being anticipated by Köth (see Office Action dated October 28, 2003). In an Interview Summary dated February 17, 2004, Examiner Kramer stated that "It was agreed that the proposed amendment overcame the reference to Köth et al by reciting that the rotor is rotatably supported with respect to the screw."

Subsequently, the claims were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,348,123 to Takahashi et al. (hereinafter "Takahashi") in a Final Rejection dated April 1, 2004. Specifically, that Office Action stated that Takahashi disclosed a rotor of the drive rotatably supported with respect to the screw. Applicants amended claims 1 and 33 to return the claim language to rotatably supported on the screw and clarified the relative positioning of the rotor and the screw as the rotor being coaxial with respect to the screw. This latter clarification alone was, however, sufficient to distinguish the subject matter of claims 1 and 33 over the applied reference. As was stated in Applicants' Amendment After Final Rejection filed on June 8, 2004, Takahashi discloses motor 3 fixed onto the outside of the frame body 2a on the upper side of the frame body 2a. Further, because of this placement on the outside and the upper side of the frame body 2a, the motor 3 and its rotor cannot be coaxial with respect to the screw.

Examiner Kramer telephoned Applicants' representative on August 11 to propose an Examiner's Amendment amending claims 1, 7, 8 and 33 as shown in the above listing of claims in order to place this application in condition for allowance. Instead of entering the Examiner's Amendment, this application was again rejected over Köth in the August 23 Office Action citing Fig. 4 rather than the previously cited Fig. 1 of Köth as the basis for the new rejection. Applicants take this opportunity to again amend claims 1 and 33 to recite wherein at least a rotatable component of the drive is rotatably supported with respect to the

screw. This amendment is not narrowing, and is made at Applicants' preference. Claims 1 and 33 are patentably distinct from the applied art for the reason discussed below.

Köth relates to an electromechanically actuatable disk brake with an actuator comprising an electric motor and a spindle/nut transmission arrangement characterized in that the electric motor is configured as an internal rotor motor with a stator and a rotor, the rotor of which is coupled non-rotatably with the spindle (Abstract). Specifically, a first end of a screw spindle 36 is accommodated in the collar 30 of the rotor 28 secured against rotation by means of a feather key 34 acting as an anti-rotation means (Fig. 1 and col. 4, lines 52-55).

Applicants respectfully submit that claims 1 and 33 are neither anticipated nor suggested by Köth because the rotor in Köth is non-rotatably coupled with the spindle, while the subject matter of claims 1 and 33 is directed to a rotor being rotatably supported with respect to the screw. Further, Applicants respectfully submit that for at least the reasons enumerated above, as argued previously, the subject matter of the claims remains patentably distinct from Takahashi as well. Applicants further respectfully submit that claims 2, 3, 7, 10, 11 and 30, which depend from claim 1, are likewise patentable over the applied reference for at least the reasons discussed above and for the additional features they recite. Finally, Applicants respectfully submit that there is nothing disclosed differently in the embodiment of Köth depicted in Fig. 4 than that depicted in Fig. 1 with respect to the relative positioning of the screw and the rotor that teaches, or would have rendered obvious, the subject matter recited in the claims.

All of the prosecution history and claim amendments were discussed with Examiner Kramer during the telephone interviews. The Examiner indicated that the above arguments were adequate to show that the subject matter of the claims was patentably distinct from the applied reference.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 7, 10, 11, 30 and 33 under 35 U.S.C. §102(b) as being anticipated Köth are respectfully requested.

The Office Action, in paragraphs 4-7, rejects claims 29, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Köth in view, respectively, of U.S. Patents Nos. 4,180,146 to Airheart, 5,293,966 to Chareire and 6,089,359 to Tanaka. These rejections are respectfully traversed.

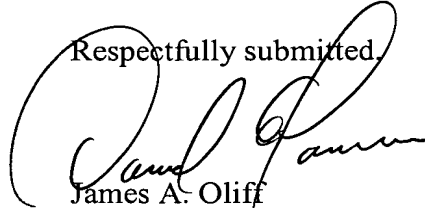
Applicants respectfully submit that none of Airheart, Chareire or Tanaka overcomes the shortfalls in the application of Köth to claim 1. Thus, claims 29, 31 and 32, which depend from claim 1, are patentable over Köth in combination with the other applied references for at least the reasons discussed above and for the additional features which these claims recite.

Accordingly, reconsideration and withdrawal of the rejection of claim 29, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over the combinations of the applied references are respectfully requested.

For at least the reasons stated above, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3, 7, 10, 11 and 29-33, in addition to the allowable subject matter of claims 4-6, 8, 9, and 12-28, are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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